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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of	:
Arthur G. Romero	:
Serial No.: 09/313,534	: PETITION DECISION
Filed: May 13, 1999	:
Attorney Docket No.: 4830.P-RE	:

This is in response to applicant's petition under 37 CFR 1.13 and 37 CFR 1.81 which is being treated as a petition under 37 CFR 1.144, filed April 5, 2002, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed as a reissue application of Patent No. 5,652,245 (issued July 29, 1997) on May 13, 1999. The application, as filed, contained original claims 1-8 in unamended form and newly added claims 9-12, directed to intermediates or precursors to the compounds claimed in claims 1-6. The examiner mailed a first Office action to applicants on March 10, 2000, rejecting the application based on a defective reissue declaration and rejecting claims 9-12 as being to inventions (compounds) not claimed in the original application which could support separate patents.

Applicants replied by filing a proper reissue declaration and arguing the rejection of claims 9-12. The examiner mailed a Final Office action to applicant on July 10, 2000, again rejecting the newly submitted reissue declaration and rejecting claims 9-12 as not to the invention originally claimed in the parent application and that they would be considered separate restrictable inventions. Applicants replied on September 15, 2000, with arguments after Final rejection which the examiner dismissed in an Advisory action mailed September 25, 2000.

Applicant filed a CPA request on December 6, 2000, accompanied by further arguments and a new reissue declaration. The examiner on January 25, 2001, mailed a new non-final Office action to applicants setting forth a formal restriction requirement, as follows:

Group I, claims 1-12 (sic - 8), drawn to compounds, composition and use, classified in class 514, subclass 292;

Group II, claim 9, drawn to an intermediate, classified in class 546, subclass 158;

Group III, claim 10, drawn to an intermediate, classified in class 546, subclass 159;

Group IV, claim 11, drawn to an intermediate, classified in class 546, subclass 162;

Group V, claim 12, drawn to an intermediate, classified in class 546, subclass 84.

The examiner held Group I, the original claims, to be constructively elected. Group I was held to be related to Groups II - V as related, but mutually exclusive species, deeming the intermediates to be useful as herbicides, insecticides, fungicides, etc. The examiner also rejected the reissue declaration as failing to set forth an error in the original patent.

Applicant replied to the restriction requirement confirming the election of Group I and traversing the requirement based on the existence of a common core in all of the compounds - the 3-amino substituted quinoline core. Applicant also requested the examiner, if maintaining the restriction requirement, to rejoin Groups I and V since they contain the same tricyclic core as the patented compounds. Applicant further states that the reissue declaration, as provided, is not defective.

The examiner mailed a Final Office action to applicants on October 5, 2001, again maintaining that the reissue declaration is defective since no error in the claims under prosecution has been alleged or pointed out. The examiner further maintained the restriction requirement to be proper and rejected claims 1-8 as based on a defective reissue declaration.

Applicant filed an argument to the Final rejection on December 5, 2001 (received January 14, 2002, due to mail delay), disagreeing with the examiner's holding of a defective reissue declaration. The examiner mailed an Advisory action on March 22, 2002, maintaining the position of the Office. Applicant then filed a Notice of Appeal on April 15, 2002, accompanied by the above noted petition.

DISCUSSION

As noted above, this application is a reissue application. A reissue application is filed to correct an error in the original patent. That error can be one of claiming too broadly or too narrowly or failing to claim a specific embodiment(s) for which proper support exists in the specification, as filed. At the time this application was originally filed, which was within two years of the patent issue date, broadening of a reissue application was permitted so long as the same invention was being claimed. In accordance with applicable rules in effect at that time the examiner rejected the added claims as being for an invention different from that claimed in the issued patent as well as holding the originally submitted declaration as defective. Applicant submitted a proper reissue declaration in reply to the examiner's holding. This reissue declaration is sufficient in pointing out the error in not claiming certain "intermediate" (precursor) compounds which have proper support in the specification, as filed. No additional reissue declaration was or will be needed unless an amendment is made to the specification or claims. The examiner repeated the holdings of the previous Office action and made the action Final prompting applicant to file a CPA request after assurance from the examiner that the filing of a CPA request would not preclude broadening of the claims. The examiner vigorously disputes having any such conversation with applicant and

it may be that such advice was given by other than the examiner assigned this application. In any event, the advice was correct.

The filing of the CPA papers created, in effect, a new application which utilized the same application number. However the new application was subject to revised reissue rules which now permitted the examiner to make a restriction requirement in a reissue application between the patented invention and additional inventions added to the reissue application. (This was not possible in the originally filed application.) The examiner then set forth a five way restriction requirement as denoted above and properly indicated the originally patented claims to be constructively elected. Applicant disagreed with the restriction requirement referring back to the examiner's characterization of claims 9-12 as being outside the scope of the original claims and for a different invention(s). Applicant traversed the requirement arguing intermediate/final product relationship and that the compounds are closely related. The examiner disagreed and maintained the requirement. It should be noted that where added claims in a reissue are held to be to a different non-elected invention and the original claims are unamended and not rejected, the non-elected claims may be made the subject of a divisional reissue application and prosecuted therein. In that instance the reissue based on only unamended original patent claims is suspended pending close of prosecution of the divisional reissue application. If claims of the divisional reissue application are found allowable, the two reissue applications will be merged and only a single reissue patent would issue. This does not apply when the original claims or specification are amended.

A review of the compounds of claims 9-12, the added claims (identified as compounds 5, 6, 7 and 8 of Example 5, Scheme 2, and structurally depicted at column 16, line 45 to column 17, line 25), shows that claims 9-11, as classified by the examiner, are classified in adjacent subclasses within the same class. Had they been presented in a single application, no restriction between them would have been possible as they all have the same bicyclic ring system and vary only in their substituents. Claim 12, however, is different from claims 9-11. The compounds of claims 9-11 are directed to bicyclic (quinoline) ring compounds substituted at the one (nitrogen) and three positions. Claim 12 compound is different in claiming a tricyclic ring system identical to that set forth in claim 1 and differs only in one of the groups attached to the amino nitrogen at the three position. Therefore, this compound, an immediate precursor to the compounds of claim 1, should be grouped with the original claims based on similarity of structure. Had this compound been claimed in the parent application the compound would have been included with the examination of the original claims. In addition, the searching of this compound cannot be said to present a burden to the examiner due to its similarity to the patented compounds. This is based on the examiner's search in the patent file of a subclass adjacent to the one in which the compound has been classified by the examiner.

The compounds of claims 9-11, which are to substituted quinoline compounds, are sufficiently different from the claimed compounds as to be considered an independent and distinct invention.

DECISION

Applicants' petition with respect to withdrawal of the restriction requirement is **GRANTED-IN-PART.**

The restriction requirement is redrafted as follows:

**Group I, claims 1-8 and 12, drawn to tricyclic compounds and methods of use;
Group II, claims 9-11, drawn to bicyclic compounds.**

Group I is constructively elected based on claims 1-8 having been patented. Claims 9-11 are withdrawn from consideration.

The application will be forwarded to the examiner for further prosecution not inconsistent with this decision. In view of this decision, the finality of the Office action mailed October 5, 2000, is withdrawn so that an action on the merits of claims 1-8 and 12 can be provided. The Notice of Appeal is held in abeyance until prosecution is again closed when it may be requested to be reinstated. If no Appeal is necessary, refund of the Appeal Fee may be requested.

Any request for reconsideration or review of this decision must be by way of a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



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